## REMARKS:

The Office Action dated June 1, 2006, has been carefully considered. In response thereto, the present paper, which is believed to be fully responsive to that Office Action, has been prepared.

Applicants wish to note that Applicants' petition to make this case special, filed June 22, 2004, was granted on August 24, 2006.

### Summary of the Office Action

Claims 26-36 are pending in the application. Claims 1-25 were cancelled in a Preliminary Amendment submitted concurrently with the originally-filed application. Claims 26 and 27 are being cancelled herewith. New claims 37-51 are being added. Thus, upon entry of this paper in the record, claims 28-51 will be pending.

In the Office Action, the Examiner has acknowledged the Applicants' claim to priority but notes that no certified copy of the foreign priority application has been submitted to the PTO.

The Examiner has objected to the specification on several grounds, as noted on page 2 of the Detailed Action.

The Examiner has rejected claims 26-36 under 35 U.S.C. § 112, first paragraph, on the basis that the specification allegedly does not support the claimed "non-controlled release" elements recited in those claims.

The Examiner has rejected claims 26-36 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,601,845 to *Buxton et al.* in view of U.S. Patent No. 6,248,363 to *Patel et al.* and U.S. Patent No. 6,270,805 to *Chen et al.*

Also in the Office Action, the Examiner has provided a response to arguments filed on March 14, 2006. In particular, the Examiner reiterated her contention that the cited references teach that the use of ethyl cellulose coating compositions is known in pharmaceutical art for its multiple characteristics, and that *Buxton et al.* in view of *Patel et al.* in particular teach multiple functions of ethyl cellulose coating composition.

The following remarks are intended to be fully responsive to the Examiner's objections, rejections, and comments.

## Objections to the Specification

### 1. Objection to the Abstract

The Examiner has objected to the Abstract of the disclosure because the specification does not disclose certain limitations recited in the claims. Applicants are not sure whether the Examiner is objecting to the Abstract or the specification. If the Examiner's objection is of the Abstract, Applicants respectfully submit that the Abstract is proper and complies with 37 C.F.R. § 1.72.

A copy of applicants' Abstract is shown below.

> A stabilized oral dosage form of an active pharmaceutical ingredient (API) such as paroxetine hydrochloride for improving the stability of the said API prior to incorporating into an oral delivery system, and a process for preparation of free flowing granules of paroxetine hydrochloride obtained by coating them with moisture barrier pharmaceutical excipients.

That Abstract is believed to be proper under 37 C.F.R. § 1.72 because it satisfies the stated purpose of having an Abstract as set forth in that regulation: "the purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure." In other words, the detailed limitations recited in the claims do not need to be reproduced or even summarized in the Abstract. Accordingly, reconsideration and withdrawal of the objection to the Abstract is requested.

To the extent the Examiner's objection is really an objection to the specification for not disclosing certain limitations recited in the claims, Applicants submit the following response.

**2. Use of "Approximately"**

With regard to the term "approximately" recited in claims 27, 30, 32, 34, and 36, the term "approximately" was included in the claims filed with the present application (see the Preliminary Amendment submitted with the application), and therefore forms part of the specification (see Applicants' previous arguments along these same lines). There is no requirement that a specification mention every term that is recited in the claims because the claims are part of the specification. *See Housey Pharmaceuticals Inc. v. AstraZeneca UK Ltd.*, 70 U.S.P.Q.2d 1641 (Fed. Cir. 2004) (noting that "[t]he claims are part of the specification."). Moreover, a specification does not have to mention the exact same term recited in the claims. *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364 (Fed. Cir. 2003) ("[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue.") (emphasis in original). Thus, Applicants believe the specification, as amended, is proper.

**3. Step C**

Furthermore, with regard to "Step C" recited in claim 28 (i.e., "A process for manufacturing a substantially moisture stable pharmaceutical product..."), that specific step was included in the claims filed with the present application (see the Preliminary Amendment submitted with the application), and therefore forms part of the specification. As noted above, a specification does have to include every term recited in a claim. *See id.* Applicants respectfully submit that Step C in the application is clear when both the specification and claims are read together.

**4. Other Claim Elements**

With regard to the element "pharmaceutical-acceptable coating comprises a gelatin capsule" recited in claim 29, which is being amended, the specific element objected to was included in the claims filed with the present application (see the Preliminary Amendment

submitted with the application), and therefore forms part of the specification. As noted above, a specification does not need to include every term recited in a claim. *See id.*

Notwithstanding the above, Applicants have previously amended the specification to incorporate most of the features recited in the claims submitted with the Preliminary Amendment. The Examiner also acknowledges that the Preliminary Amendment was filed with the original application, and therefore forms part of the specification. Now, however, the Examiner appears to be suggesting that the amended claim language also be incorporated into the specification (the Examiner cites M.P.E.P § 608.01(b) for authority; however, that section deals with the "Abstract of the Disclosure," not the specification generally). For the reasons noted above, it is not believed that every feature of the claims is required to be recited in the specification. Nevertheless, Applicants will revisit this issue after the claims have been allowed to assess whether the specification should be further amended to be more consistent with the language in the allowed claims.

Accordingly, reconsideration and withdrawal of the objections to the Abstract and the specification are respectfully requested.

**Rejection of Claim 26-36 Under 35 U.S.C. § 112, First Paragraph**

The Examiner has rejected claims 26-36 under 35 U.S.C. § 112, first paragraph, on the basis that the specification allegedly does not support the claimed "non-controlled release" elements recited in those claims. The Examiner states that the specification discloses a film coating made of hydrophobic coating materials such as hydroxypropyl methyl cellulose (HPMC) to help retard against degradation. One of the causes for degradation, according to the Examiner, is the acid pH in the stomach. Thus, many acid labile drugs are coated with hydrophobic materials to control the release of the drug in the GI tract. This fact is evidence, according to the Examiner, by the teachings of U.S. Patent No. 4,927,640 to *Dahlinder et al.* The Examiner appears to argue that the common knowledge in the art suggests that the Applicants' specification does not provide support and/or guidance as to how the hydrophobic coating

formulation of the instant invention can be a "non-controlled release formulation." For the reasons noted below, Applicants respectfully disagree with the Examiner's contentions.

First, as noted previously, Applicants are hereby cancelling claims 26 and 27, thereby rendering the rejection of those claims as moot.

Second, as indicated in Applicants' previous reply to an earlier Office Action, the dosage form claimed is not a controlled release formulation, but instead is a "normal release" or "immediate release" formulation with improved moisture stability. See page 7, lines 20-22, of the application. The cellulose material provides stability from moisture degradation but does not affect the release of the active ingredient in the GI tract of a mammal. For example, the Examples in the specification show an amount of ethyl cellulose that is nearly 1% weight by weight of the active drug, which one of ordinary skill in the art would appreciate does not form a controlled release coating. The mere fact that prior art references teach multiple uses of ethyl cellulose, including its use in controlling the release of an active ingredient, does not convert the instant invention from a normal release formulation into a controlled release formulation.

Nevertheless, Applicants have amended the claims to clarify the nature of the invention by adding functional language to describe the coating layer as one that is "adapted to allowing normal release of said drug substance in a gastro-intestinal environment of a mammal." Support for that language may be found on page 7 of the application as noted above. Applicant's wish to point out that the term "normal release" and "immediate release" (used in the specification) would be understood as being synonymous to those of ordinary skill in the art. As Applicants pointed out in earlier replies, drugs products are generally considered to be either normal- or immediate-release formulations, or controlled-release formulations.

Accordingly, because it is clear from the specification that the Applicants were in possession of an invention involving a normal release drug product, reconsideration and withdrawal of the rejection of claims 28-36 are respectfully requested.

**Rejection of Claims 26-36 Under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 26-36 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,601,845 to *Buxton et al.* in view of U.S. Patent No. 6,248,363 to *Patel et al.* and U.S. Patent No. 6,270,805 to *Chen et al.* For the following reasons, Applicants respectfully traverse the Examiner's rejection of those claims because the Examiner has not established a *prima facie* case of obviousness.

The Examiner correctly acknowledges that *Buxton et al.* does not teach or suggest making a "normal release" drug substance coating or drug formulation. In fact, *Buxton et al.* discloses controlled-release oral diltiazem formulations (see claims 1 to 17; col. 2 to 3). The excipients taught in *Buxton et al.* are used for achieving the controlled release film coating for the active ingredient (see col. 3, beginning at line 3), which results in a slow release of a drug over extended period of time and extends the duration of action of the active drug (see col. 2, lines 1-5). The product described in *Buxton et al.* comprises a spheroid core that is coated with a slow release coating material. The spheroid core also includes a spheronizing agent and other pharmaceutically acceptable excipients to facilitate spheronization and is processed to form spherical granules/beads. This spheroid core is coated with a controlled release coating comprising water insoluble cellulose derivatives and water soluble polymers, plasticizers, surfactants etc. (see col. 2, lines 10-55).

*Chen et al.* also discloses a controlled release formulation (for water soluble drugs) (see col. 2, line 65, col. 3, beginning at line 13, and claims 1 to 18). The disclosed product comprises a biologically inert core, which is first coated with a water soluble drug, and a polymer binder. The resultant product is further coated with a second coating of enteric coating material. Ethyl cellulose is exemplified as the controlled release coating material. Moreover, *Chen et al.* neither states that it provides a stabilizing formulation nor suggests such a purpose.

Thus, neither *Buxton et al.* nor *Chen et al.* teach normal release (i.e., non-controlled release) drug product formulations using an ethyl cellulose and surfactant coating, nor do they suggest or imply such a drug product. Moreover, neither patent suggests an ethyl cellulose and surfactant coating that is adapted to providing a normal release formulation with aqueous

stability during storage or granulation/formulation. Furthermore, neither patent implies a normal release formulation of paroxetine.

Turning now to *Patel et al.*, the Examiner contends that *Patel et al.* teaches using the claimed polymer for "a variety of reasons," including "particle porosity reduction, reduce dust, chemical protection, mask taste, reduce odor, and the like (see col. 42, lines 22-28), which, according to the Examiner, provides the motivation to one of ordinary skill in the art to modify the invention disclosed in *Buxton et al.* However, the Examiner correctly notes that *Patel et al.* does not specifically disclose using the claimed polymers for inhibiting moisture degradation while providing for normal release of an active ingredient, which reflects the nature of the problem being solved by the present invention.

In fact, *Patent et al.* identifies use of ethyl cellulose (see col. 42, lines 28-32) as follows: "....water soluble cellulose ethers are preferred for this application. HPMC and ethyl cellulose in combination, or Eudragit E100 are particularly suitable for taste masking applications...." (see also the Abstract and "Examples"). A seal coating is generally applied to final dosage forms, like tablets, to obtain the properties recited in *Patel et al.* In the present application, at page 8, lines 8-9, an optional seal coating with hydrophobic materials are provided on the compressed tablets to help retard degradation. This itself is a sufficient showing that such coating cannot, by itself provide moisture stability during formulation and storage to highly moisture sensitive or unstable drugs like paroxetine anhydrate.

Given the above, it cannot be concluded that the three cited reference alone or in combination with each other provide to a person of ordinary skill in the art at the time of the inventions the necessary motivation to modify the invention in *Buxton et al.*, a controlled-release formulation, to arrive at the claimed normal release formulation having a stabilized form of paroxetine hydrochloride, i.e., one that improves the stability of the drug by protecting the naturally hygroscopic paroxetine hydriochloride by coating the drug with certain disclosed moisture barrier excipients such as ethylcellulose and polysorbate 80. One of ordinary skill in the art would not have been motivated to modify or combine the references to arrive at the instant invention because the references do not disclose nor suggest a normal release

formulation, nor even suggest aqueous stability. Rather they only discuss formulating a water-soluble drug to control the release profile of the active ingredient. Without the necessary motivation, either suggested by the cited references or by the nature of the problem solved by the present inventions, the references do not establish a *prima facie* case of obviousness.

Accordingly, Applicants submit that the Examiner has not established a *prima facie* case of obviousness with regard to the composition claims of the present application.

With regard to the process claims in the instant application, the manufacturing process described in *Buxton et al.* includes three steps: 1) an active spheroid core of drug is formed by granulation of drug substance, a spheronization agent and an optional excipent; 2) the spheroid core containing the drug is then coated with a controlled release coating of ethyl cellulose to make coated granules; and 3) the coated granules are incorporated into a hard gelatin capsule (unit dosage form) (see the "Examples" on col. 3 and 4). The claimed process of the instant application, on the other hand, includes coating the active drug sufficient enough to make it moisture stable and granulating said moisture stable drug core being incorporated into a unit dosage form having property for normal release, which is clearly not disclosed or suggested in *Buxton et al.*

Accordingly, Applicants submit that the Examiner has not established a *prima facie* case of obviousness with regard to the process claims of the present application.

Because the Examiner has not established a *prima facie* case of obviousness, reconsideration and withdrawal of the rejection of claims 28-36 are respectfully requested.

With regard to Applicants' previous statement about the criticalness of the ratio of surfactant and ethylcellulose, all statements about the claimed ratio being critical are hereby withdrawn and not relied upon at this time for purposes of differentiating the claimed invention from the prior art.